

No. 39.

UNITED STATES CIRCUIT COURT OF APPEALS
NINTH CIRCUIT.

October Term, 1891.

HUNT BROTHERS FRUIT PACKING COMPANY,
Plaintiff in Error,

VS.

JOHN W. CASSIDY,
Defendant in Error.

BRIEF FOR DEFENDANT IN ERROR.

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IN THE
United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

HUNT BROS. FRUIT PACK-
ING COMPANY,

Plaintiff in Error,

vs.

JOHN W. CASSIDY,

Defendant in Error.

No. 39.

ON WRIT OF ERROR.

Action at law by defendant in error against plaintiff in error to recover damages for infringement of a patent; trial by jury; verdict for defendant in error for \$1,350, and judgment accordingly. The case is brought here by writ of error.

The patent in suit was granted to John W. Cassidy on Jan. 25, 1876, is numbered 172,608, and covers "Improvements in drying apparatus," used for drying fruits, vegetables and other products. It contains two claims. Infringement is charged of the second one only.

The drier is a "stack drier," containing an

upright drying chamber provided with laterally disposed trays and a mechanism for moving them from the bottom to the top of the stack, each tray, filled with undried fruit, being inserted at the bottom and gradually moved upward to the top, where it is then removed. A furnace in the bottom of the stack underneath the trays furnishes ascending currents of heat.

The device covered by the first claim is a system of flues for evenly distributing the heat. No infringement thereof is charged and it may be dismissed from consideration.

The second claim covers a mechanism for moving the trays upward through the stack or drying chamber. It consists of four stationary posts, one at each corner of the drying chamber, vertically disposed, extending from the bottom to the top and provided at intervals with spring catches, which extend into the chamber at right angles, forming seats for the edges of the trays and adapted to recede for the trays to pass over them, combined with four movable posts adjacent to the stationary posts, provided with similar catches registering laterally with the catches on the stationary posts, and any suitable mechanism for moving them by a vertical reciprocating motion within the chamber. The operation is as follows: The two sets of posts being so disposed that their

respective catches will register in a horizontal plane, a tray of undried fruit is inserted laterally through a door at the bottom and caused to rest on the lowermost set of catches, the lifting mechanism is then set in motion by any suitable power, hand or otherwise, the movable posts are thereby moved upward a step until the top of the tray comes in contact with the second set of catches on the stationary posts, which are thereby depressed into a slot, the tray then moves over the depressed catches, which, when the tray passes, spring back into normal position and allow the tray to rest thereon. By a reverse movement of the lifting mechanism the movable posts are then caused to descend to their initial position, another tray is inserted and the former operation repeated until the first tray reaches the top and the stack is full. When sufficiently dried the trays of fruit are taken out one by one at the top through a side door.

The second claim reads as follows:

“In combination with a drier the stationary posts K, provided with spring catches $n n$, and the vertically moving posts L, provided with spring catches $n^1 n^1$, and suitable mechanism for operating the posts L, substantially as and for the purpose set forth.”

The defendants have used a mechanism substantially similar, except that they have substituted

for the spring catches, catches which fall out by gravitation, referred to in the Record as "gravity catches."

The specification of the patent says:

"Catches which would fall out by gravitation might be substituted for the springs in some cases."
(Record 11.)

The evidence shows that Cassidy made his invention in April, 1874, and in his first drier used gravity catches. Defendants, when on the witness stand, admitted that their gravity catches were the mechanical equivalents of Cassidy's spring catches, and their counsel concede it in their brief.

In preparing our brief we have been put to great disadvantage by reason of the peculiar tactics pursued by opposing counsel. Though the Record shows 41 assignments of error, yet their brief contains no assignment of the *errors relied on*, nor does it set out separately and particularly *the errors relied on and intended to be urged*, thereby directly violating Rule 24 of this Court.

On the contrary their brief is a confused mass of argument, without any order or system, and leaves to the ingenuity of the reader the task of fishing out from the Record the particular assignments of error relied on and then applying thereto the appropriate part of the argument. For the

purpose, however, of relieving the Court from this unusual and most unreasonable labor, we have endeavored to evolve some system and order out of counsel's chaotic brief, by bunching their numerous assignments of error. We hope thereby to put the matter into intelligent form.

As near as we can figure out the matter, the assignments of error found in the Record may be grouped as follows:

1. Alleged errors in the admission and rejection of testimony, represented by Assignments 1, 3, 4, 5, 6, 7, 8 and 9.

2. Alleged error in refusing to instruct the jury, at the close of plaintiff's case in chief, to render a verdict for defendant, represented by Assignment 2.

3. Alleged errors in refusing to give to the jury certain instructions requested by plaintiff in error concerning matters appearing in the file-wrapper of Cassidy's patent, represented by Assignments 10, 11, 12, 13, 14 and 15.

4. Alleged error in refusing to instruct the jury concerning the prior Alden drier, as requested by plaintiff in error, represented by Assignments 16 and 17.

5. Alleged error in refusing to instruct the

jury concerning the prior patent of Button, as requested by plaintiff in error, represented by Assignments 18, 19, 20, 21, 22, 23, 24 and 25.

6. Alleged error in instructing the jury on the subject of mechanical equivalents, represented by assignments 35, 36, 37, 38, 39 and 40.

7. Alleged error in instructing and refusing to instruct the jury on the question of damages, represented by assignments 26, 27, 28, 29, 30, 31, 32, 33, 34 and 41.

Before proceeding with our argument we desire to call attention to one fact which seems to have escaped the attention of counsel for plaintiff in error, or at any rate it is ignored by them. This case is brought here by writ of error, because it was an action at law. Consequently, the review by this Court can extend only to matters of law. All questions of fact, which were submitted to and passed upon by the jury, must be deemed to be conclusively determined, and are not reviewable in this Court.

Says Mr. Justice Nelson as early as 1846, in the case of *Zeller's Lessee vs. Eckert et al.* (4 How., 298):

“ We have no concern, on a writ of error, with questions of fact, or whether the finding of the jury accords with the weight of the evidence. The

law has provided another remedy for errors of this description, namely, a motion in the Court below for a new trial, on a case made.”

The learned Justice than proceeds to condemn in the most caustic terms the practice of incorporating the entire charge and evidence in a bill of exceptions, saying that it only served “to encumber and confuse the record, and to perplex and embarrass both court and counsel.”

This rule has been consistently followed by the Supreme Court ever since.

Bank, etc. vs. Cooper (137 U. S., 474).

C. and N. W. R. R. Co. vs. Ohle (117 Id., 123).

Lancaster vs. Collins (115 Id., 222).

Express Co. vs. Ware (20 Wall., 543).

Packet Co. vs. McCue (17 Id., 508).

Gregg vs. Moss (14 Id., 564).

Barreda vs. Silsby (21 Id., 146).

Hyde vs. Stone (20 Id., 170).

York R. R. Co. vs. Meyers (18 Id., 252).

Arthurs vs. Hart (17 Id., 14).

U. S. vs. Morgan (11 Id., 158).

Phillips vs. Preston (5 Id., 289).

Johnson vs. Jones (1 Black., 220).

Parsons vs. Bedford (3 Pet., 433).

Yet counsel for plaintiff in error have argued the case just as if it were an appeal in an equity

case, where all the *facts* are reviewable as well as the *law*, or as if the case were on final hearing before a *nisi prius* court. In other words, their contention practically is that the evidence is insufficient to support the verdict, and we are treated to page after page of dissertation in their brief on that theory. For instance, take from near the bottom of page 12 to below the middle of page 15, and we find an argument that Cassidy's patent was anticipated, or at least was void for lack of invention by reason of certain prior patents, which were offered in evidence. Now anticipation and want of invention are simple *questions of fact* to be passed on by a jury, and when so passed on, cannot be reviewed on a writ of error.

Turrill vs. R. R. Co. (1 Wall., 491)

Tucker vs. Spaulding (13 Id., 453).

Bischoff vs. Wethered (9 Id., 812).

The above is given as one of the glaring illustrations of counsel's line of argument, but the entire brief appears to be framed on the same theory. That such is not the law, and will not be tolerated by this Court is well settled by the rules of appellate practice, and no one ought to know it better than counsel for plaintiff in error.

Having premised this much for the purpose of eliminating from the case such irrelevant and unreviewable questions as are found argued in the

brief of opposing counsel, we now turn our attention specifically to the alleged errors, following the order indicated in the grouping hereinabove made, and taking up each group *seriatim*.

I.

ALLEGED ERRORS IN THE ADMISSION AND REJECTION OF EVIDENCE—REPRESENTED BY ASSIGNMENTS OF ERROR 1, 3, 4, 5, 6, 7, 8 and 9.

The first one of these is too trivial to dwell on at length. Mr. Cassidy was asked what, in his judgment, would be the comparative cost between his drier and the Alden. This question was objected to and the objection was overruled. In this there was no error. The witness was a mechanic by trade and had had long experience in building fruit-driers. He knew exactly what the cost of his own drier was; but not having built any Alden driers, he did not know their *exact cost* of his own knowledge. However, he was perfectly familiar with them, had seen them constructed and operated for years, and was an expert mechanic and practical builder of fruit-driers. Under such state of facts it was competent for him to compare the cost of the two driers, and there was no error in allowing him to do so.

But were there any force in the objection it could not be considered here because not properly

framed in the Court below. The objection interposed in the Court below was as follows:

“ Mr. Wheaton—I object because the witness says he does not know what the Alden drier would cost.”

The question asked was not what the Alden drier would actually cost, but which, in the witness' judgment, would be the cheaper to construct, his drier or the Alden. (Record 20.) The witness was only asked for his *opinion*, his best *judgment*, not for the *exact fact*. The objection interposed was not that such opinion was incompetent, but was based on the contention that the witness did not know the *exact fact*, a thing which was not asked him and was not included in the question. If counsel had objected on the ground that the witness' *opinion* or *judgment* on the matter was incompetent, that would have been the same objection which they now urge in this Court. They interposed no such objection in the Court below. Consequently it cannot be considered here.

In regard to the remaining assignments of error under this grouping, being 3, 4, 5, 6, 7, 8 and 9, counsel say in their brief: “ While we do not intend to waive any of the exceptions between the second and tenth, we will not stop to make an argument upon them.” (Brief 12.)

Under well settled rules of appellate practice this amounts to a waiver of said exceptions. If a party alleging error does not specifically point it out, certainly he cannot expect the Court to perform that service for him. We take it, therefore, that these particular exceptions will not be considered at all, and consequently, we pass them by.

“Where no argument has been submitted for the plaintiff in error, the Court infers that the exceptions have been abandoned.”

Duwall vs. United States (18 U. S. Law Ed., 252).

II.

ALLEGED ERROR OF THE COURT IN REFUSING TO INSTRUCT THE JURY, AT THE CLOSE OF PLAINTIFF'S CASE IN CHIEF AND BEFORE DEFENDANT HAD INTRODUCED ANY EVIDENCE, TO RENDER A VERDICT IN FAVOR OF DEFENDANT.
ASSIGNMENT OF ERROR No. 2.

At page 30 of Record it appears that after the plaintiff had closed his case in chief, and before any evidence was offered by defendants, and without resting their case, counsel for defendant made this request of the Court:

“Mr. Wheaton—We will ask your Honor for an instruction that the jury should bring in a verdict for the defendant, on the ground that the

plaintiff's own testimony shows that the change that he made consisted of substituting these posts and spring catches—or other catches, I will not make a point on the word spring, for the chains and lugs in the same kind of a drier.”

This motion was denied and exception was taken. Thereupon the defendant proceeded to and did introduce a large mass of testimony in defense of the action. The plaintiff then introduced evidence in rebuttal and rested. *No motion was then made for an instruction to the jury to bring in a verdict for defendant*, but the entire case was argued on its merits by both counsel for plaintiff and defendant, and after the charge by the Court, was submitted to the jury in the usual manner, who promptly rendered a verdict in favor of the plaintiff.

Under these circumstances the alleged error, if any there be, in the Court's refusal to give the instruction asked for, is waived.

It is a settled rule that such a motion cannot be made by a defendant as of right, *unless at the close of the whole evidence in the case*; and that, if the defendant, at the close of the plaintiff's evidence, and without resting his own case, requests and is refused such ruling, the refusal cannot be assigned as error in the Appellate Court.

In *Accident Insurance Co. vs. Crandall* (120 U. S., 530), a precisely similar state of facts arose:

“ At the close of the plaintiff’s evidence, the defendant moved the Court to instruct the jury that, under the law and the evidence in the case, the plaintiff was not entitled to recover. The Court overruled the motion, and the defendant excepted. The defendant then introduced evidence, and the case was argued to the jury.” (Page 529.)

Upon this state of facts, Mr. Justice Gray said:

“ The refusal of the Court to instruct the jury, at the close of the plaintiff’s evidence, that she was not entitled to recover, cannot be assigned for error, because the defendant, at the time of requesting such an instruction, had not rested its case, but afterwards went on and introduced evidence in its own behalf.”

On a similar state of facts a similar ruling was made in *Northern Pacific R. R. Co. vs. Mares* (123 U. S., 713), Mr. Justice Mathews, delivering the opinion of the Court and affirming *Accident Insurance Co. vs. Crandall*. The ruling was adhered to and the doctrine re-affirmed in *Robertson vs. Perkins* (129 U. S., 236), where Mr. Justice Blatchford said:

“ The motion was denied by the Court, and the defendant excepted. But, as the defendant did not then rest his case, but afterwards proceeded to introduce evidence, the exception fails. *Accident Ins. Co. vs. Crandall*, 120 U. S., 527.”

The latest ruling on the point is found in *Columbia and P. S. R. Co. vs. Hawthorne* (12 Sup. Ct. Rep., 592), decided on April 4, 1892, where Mr. Justice Gray said:

“ The question of the sufficiency of the evidence for the plaintiff to support his action cannot be considered by this Court. It has repeatedly been decided that a request for a ruling that upon the evidence introduced the plaintiff is not entitled to recover cannot be made by the defendant as a matter of right, unless at the close of the whole evidence, and that, if the defendant at the close of the plaintiff's evidence, and without resting his own case, requests and is refused such a ruling, the refusal cannot be assigned for error.”

The facts of our case brings us squarely within the rule of the above citations. At the close of plaintiff's case, the defendant, without resting its own case, requested the ruling, which was denied. Thereafter the defendant introduced evidence and argued the case to the jury, without any further request that the Court should instruct the jury to render a verdict in its favor. We say, therefore, the exception is waived and cannot be assigned as error in the Appellate Court.

No one of the cases cited by counsel for plaintiff in error is contrary to these views. In the first one, *Randall vs. Baltimore and Ohio R. R.* (109 U. S., 480), the Court says:

“ *At the close of the whole evidence* the Court directed the jury to return a verdict for the defendant, because the evidence was such that if a verdict should be returned for the plaintiff, the Court would be compelled to set it aside.”

In the second one, *Heald vs. Rice* (104 U. S., 737), it is said:

“ The Court was asked at the close of the plaintiff’s testimony, *and again when all the evidence on both sides had been introduced*, to instruct the jury to return a verdict for the defendant.”

In the third one, *Fond du Lac County vs. May* (137 U. S., 395), the Court says:

“ No evidence in rebuttal was offered by the plaintiff, and *the testimony being closed, the defendant renewed its motion for a verdict to be directed for it*, on the grounds before stated; but the motion was denied and the defendant excepted.”

In the fourth one, *May vs. Juneau County* (137 U. S., 408), the Court says:

“ *At the close of the testimony on both sides*, the defendant moved the Court to direct a verdict for the defendant, etc., etc. The Court granted the motion and directed the jury to return a verdict for the defendant, which was done.”

In all of these cases the motion was made *at the close of the whole evidence*, and that was the proper time. In the case at bar counsel for plaintiff in error made their motion *at the close of plaintiff’s case in chief*, without resting their own case and

before introducing any evidence in defense. The motion was denied, and thereupon the defendant introduced its evidence in defense, the plaintiff introduced evidence in rebuttal, and the case was then argued and submitted to the jury. The defendant did not, *at the close of all the evidence, renew its motion.* On the contrary, its counsel seemed to acquiesce in our contention that they were not entitled to the instruction, because they propounded and requested instructions, in which the question of fact involved in its motion was left to the jury. By that course they plainly receded from the position which they had before taken and which they now take in their brief. If they had desired to save the point in this Court, they should have rested their case at the time they requested the instruction, or should have renewed the request at the close of the entire testimony when they did finally rest their case. They did neither. They tried to get the ruling in the first instance as a matter of law when the case was but half tried, and failed. They then tried another tack, by introducing evidence and asking the Court to instruct the jury that the patent would be void, if they found *as a matter of fact* that the Alden was an anticipation. In this, too, they failed, but in pursuing this course they waived their exception to the Court's first ruling. The Court found

against them as a question of law, and the jury found against them as a question of fact.

This *question of fact* having been submitted to the jury, the defendant cannot now complain of the verdict thereon. In actions at law this Court cannot review the facts passed on by the jury, but only questions of law; and where a litigant submits a disputed question of fact to a jury, he is bound by the verdict rendered thereon, unless the Court grants him a new trial, and cannot in the Appellate Court claim that it is a question of law, and, as such, reviewable. All contested questions of fact submitted to a jury are conclusively settled by the verdict. They are not reviewable in the Appellate Court.

Lancaster vs. Collins (115 U. S., 222).

Bank, etc., vs. Cooper (137 Id., 474).

We submit that no such legal jugglery as is now being attempted by counsel for plaintiff in error will be allowed. They will not be allowed to play fast and loose at the same time.

These considerations dispose of the major part of counsel's brief. All that portion of it from the middle of page 2 to the middle of page 12 is devoted to the above mentioned assignment of error No. 2, and may therefore be dismissed from further consideration, inasmuch as said assignment of error is not available in this Court.

But even if said assignment of error were open for consideration here, still there would be no merit in the contention.

There is no resemblance whatever between the Alden and Cassidy machines, further than the fact that they are both stack driers. But the Cassidy claim is not for a stack drier. It is for a peculiar mechanism to lift the trays in a stack drier. That mechanism is of an entirely different construction from Alden's. It operates on a different principle and in a different manner. In Alden's there are four endless chains, one in each corner of the stack, running over sprocket wheels and all geared together by a complicated mechanism, not shown by the evidence, to make them run synchronously. They have lugs attached at appropriate intervals, which project forward at right angles to form seats for the fruit trays: The chains have an upward continuous motion, always in one direction. Being flexible they are liable to buckle or twist when striking an obstruction. If they break, the entire column or stack of trays falls in a heap to the ground.

In the Cassidy device the movable posts have a vertical reciprocating, not a continuous motion. They move upward a step and then move downward a step. They have a step-by-step movement which is entirely different from the Alden con-

tinuous movement. The posts are rigid, not flexible, and hence they are not liable to buckle or twist. They are enclosed in slots or grooves and are not liable to meet obstructions and become broken. They are cheaper than the chains and lugs. In every way they are more effective.

As proof of this the evidence shows that Cassidy's invention immediately went into use and the public generally began copying it. "It had a tendency of rather revolutionizing the fruit-drying business, for immediately after I got my patent most everyone was using these devices East. They were using my catches and sliding posts," says Cassidy. (Record 19.) Whereas the Alden drier, which had previously been generally known and used, went out of use on the Pacific Coast about the year 1875 and has not been there used since although the patent has expired. (Record 20.)

Further, Cassidy testifies positively that the lifting mechanisms of the two driers are of different construction; that they operate in different ways: *that they are NOT mechanical equivalents* (Record, pp. 24-5.) In view of these facts and this testimony, all of which is admitted to be true by the motion, it seems puerile to contend that the Court should have held as matter of law the two driers to be the same, and instructed the jury to render a verdict for the defendant on that ground.

Counsel's precise contention is that all Cassidy did was to substitute sliding posts and catches for the Alden chains and lugs. That might be admitted, and still his conclusion would not follow, because the sliding posts and catches are not mechanical equivalents of the chains and lugs. Cassidy so testifies, which testimony must be taken as true, and the construction and operation of the two devices confirm this testimony. In their argument counsel have lost sight of these facts.

And right here it may not be out of place to enquire, when a trial Court is justified in giving such an instruction.

In *Royer vs. Schultz Belting Co.* (135 U. S., 325), the infringing machine was of a different construction from the patented machine, though working on the same general plan and accomplishing the same result. At the close of plaintiff's testimony the defendant demurred to the evidence. The Court sustained the demurrer and directed the jury to find for defendant. (28 Fed. Rep., 850.) In reversing the judgment the Supreme Court said:

“ We think the Circuit Court erred in not submitting to the jury the question of infringement under proper instructions. * * * It was not a matter of mere judicial knowledge that the mechanical differences between the two machines were material, in view of the character of the patented

invention and of the claims of the patent; and we are unable to concur with the view of the Circuit Court, in its opinion denying the motion for a new trial (29 Fed. Rep., 281), that this is a case where, if the jury had found a verdict for the plaintiff, on the evidence put in by him on the question of infringement, all of which evidence the bill of exceptions states is set forth therein, it would have been proper for the Court to set aside such verdict. *Keyes vs. Grant*, 118 U. S., 25."

In the case of *Keyes vs. Grant* cited *supra*, a certain prior publication was put in evidence as an anticipation. Upon comparison of the two the Court was of the opinion that they were so nearly identical as to negative any invention on the part of the patentee, and instructed the jury to find for the defendant. The Supreme Court reversed this ruling, saying *inter alia*:

"Clearly it was not matter of law that the specification of the plaintiff's patent and the publication of Karsten, taken in connection with the drawings intended in illustration, described the same thing. The differences were obvious in the arrangement of the parts and the relation of the basin in one and the fore-hearth in the other to the interior of the furnace, and the mode of connecting the one with the other for the purpose of drawing the metal from the furnace. So that it was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result, or, if material at all, were only such as would not require the exercise of the

faculty of invention, but would be suggested by the skill of an experienced workman employed to produce the best result in the application of the well known arrangements of the furnace.”

These cases would seem to dispose of counsel's theory. Undoubtedly the Alden and Cassidy devices were of different construction. This difference was striking and radical. The chains and lugs of one had no mechanical similarity whatever to the sliding posts and catches of the other. Moreover, their modes of operation were different, one having a continuous motion in one direction, and the other a vertical reciprocating motion. They accomplished the same result, so far as lifting the trays in a stack drier, but did it in a radically different way and by a radically different mechanism. Besides, both Cassidy and the expert testified that they were not mechanical equivalents. Therefore we say in the language of the Supreme Court—*it was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result, or, if material at all, were only such as would not require the exercise of the faculty of invention, but would be suggested by the skill of an experienced workman employed to produce the best result in the application of the well known arrangements of the furnace (drier).*

This language could not be apter if it had been

framed specially with a view to the case now before the Court.

But further, if we view the question as one of law, though it was undoubtedly a question of fact, the ruling of the lower Court was correct. The combination of elements in Cassidy's second claim calls for, (1) a drier; (2) four stationary posts; (3) catches thereon; (4) movable posts having a vertical reciprocating motion; (5) similar catches thereon, and (6) mechanism for operating the movable posts.

Unless the equivalents of *all these elements* were found in the Alden drier, counsel's contention fails. Now the Alden drier did not have *four stationary posts provided with catches, nor any pretense thereof, nor any equivalent thereof*. That element was entirely wanting. Nor did it have the *movable posts carrying similar catches and having the vertical, reciprocating motion*. It had a flexible chain carrying lugs, operating always with a continuous motion in one direction. These were not mechanical equivalents of Cassidy's sliding posts and spring catches. At no stage in the Alden operation was a tray caused to depress a catch, pass over it, and then rest on the next catch above. The tray rested on the single set of lugs during its entire progress from top to bottom. The two operations were entirely different in *the*

manner of performance. The one was the continuous circular motion of a wagon wheel, the other the reciprocating rectilinear motion of an engine piston-rod. Hence, they were not equivalents, and the premises of counsel, on which he bases his conclusion of law, have no foundation in fact. He always assumes that the two devices are equivalents, merely because they attain the same end, and loses sight of the fact that they attain that end *in a different manner and by a different mechanism.*

We submit that the Alden drier does not affect the Cassidy patent in any light it may be viewed, whether as a question of law or one of fact. Indeed counsel for plaintiff in error thought so little of it that they did not even set up the Alden as an anticipating device in their pleadings, although they did set up a large number of other driers as such, nor did they even produce in evidence the Alden patent itself. They merely took oral testimony of its construction. If they have any confidence in the position they now take, it is a little singular that such omissions should have occurred. It appears to us that the contention is a mere afterthought, a mere make-shift for the want of better arguments, an effort to confuse and befog the Court with a piece of complicated mechanism of which there is no sufficient or proper evidence in

the Record. We are constrained to think that the contention is not made in good faith, because the long experience of counsel ought to teach them better.

III.

ALLEGED ERROR OF THE COURT IN REFUSING TO GIVE CERTAIN INSTRUCTIONS REQUESTED BY PLAINTIFF IN ERROR CONCERNING CERTAIN MATTERS APPEARING IN THE FILE-WRAPPER OF CASSIDY'S PATENT. ASSIGNMENTS OF ERROR 10, 11, 12, 13, 14, 15.

So far as the 10th and 15th assignments are concerned, they are not good, for the reason that the Court gave in its own language to the jury substantially the instructions requested. On page 112 of the Record, from line 13 to line 30, we find that these points are fully covered by the Judge's charge to the jury. Hence there was no necessity to repeat the matter, and refusal to do so was not error.

In regard to the 11th assignment above referred to, the most casual reading shows it to be immaterial.

The 12th, 13th and 14th are not good, because the instructions there refused were purely matters of law for the Court, and not for the jury. The construction of a patent is always a matter of law

for the Court. It is the province of the Court to determine its proper construction, and then to give such construction to the jury. In this case, for instance, it was the duty of the Court to first determine as *matter of law* whether the patent covered gravity catches as well as spring catches. This the Court did do and instructed the jury accordingly. But the instructions embodied in the 12th, 13th and 14th assignments undertook to cast upon the jury the determination of that question of law. In other words, it was calling upon the jury to construe the patent. Consequently it was proper to refuse them, and it would have been error to give them, because the matter was solely a question of law for the Court.

IV.

ALLEGED ERROR IN REFUSING TO INSTRUCT THE JURY CONCERNING THE PRIOR ALDEN DRIER, AS REQUESTED BY PLAINTIFF IN ERROR. ASSIGNMENTS OF ERROR 16 AND 17.

The substance of the instructions embodied in these assignments of error had already been given to the jury by the Court in its general charge, and hence, it was not error to refuse them. From the bottom of page 112 to the top of page 115 of the Record will be found a full, fair and most careful charge to the jury concerning the Alden drier.

It leaves absolutely nothing to be said on the subject. It contains the substance of all that was proper in the 16th and 17th assignments, besides a great deal more.

But there is another reason why the 17th assignment is bad and it is this: The instruction requested assumed *as a fact* that the lifting device of the Cassidy patent was a mechanical equivalent of the Alden. But that was the very point in issue, and it was a question of fact to be decided by the jury. Hence it would have been a palpable error to give such instruction.

V.

ALLEGED ERROR OF THE COURT IN REFUSING TO INSTRUCT THE JURY CONCERNING THE PRIOR PATENT OF BUTTON, AS REQUESTED BY PLAINTIFF IN ERROR. ASSIGNMENTS OF ERROR 18, 19, 20, 21, 22, 23, 24 AND 25.

The 18th assignment is clearly frivolous in so far as it tells the jury that a patent was granted to Button on September 22, 1874, because the patent was in evidence and the jury knew that fact. In so far as the instruction undertakes to tell the jury that the Button patent was applied for on July 20, 1874, it is clearly erroneous, because:

1. Whatever effect the Button patent has as an

anticipating patent, must date from its issuance, not from its application; and

2. There was no competent evidence in the case showing the date of the application.

It is well settled that when a prior patent is set up as an anticipation, the date of the *issuance* of the patent is the material point to determine, and the date of the application is utterly immaterial, irrelevant and incompetent. This results from the provisions of the statutes (R. S., § 4886), which provide that patents may be issued for inventions which had not been before *patented*, etc., and (R. S., § 4920), that a patent sued on will be declared void, if the defendant show that the invention had been *patented* before by others. In other words, patents can be anticipated by prior *patents*, not by prior *applications*.

See 1 Robinson on Patents, § 332, and cases cited.

Nor was there any competent evidence showing the date of Button's application, even if that application could cut any figure in the case. The only evidence of the date of that application is the memorandum appearing in the space under the title on the specification. But that is not competent evidence of the fact.

Walker on Patents, § 129.

Brush vs. Julien Co. (41 Fed. Rep., 688).

The 19th and 20th assignments are not good, because the instructions therein requested are not true as matter of fact. Those instructions are both based on the assumption that the Button patent has "catches without springs." But, as matter of fact, such assumption is false. The Button patent has no such catches, but has spring catches. Hence the instructions were properly refused.

The 20th assignment is not good for another reason. It undertakes to say, that, if the Button catches were used "prior to the time that the plaintiff *applied for his patent*," then no invention is shown in Cassidy's patent. It should have been prior to Cassidy's *invention*, not prior to his *application for the patent*. A patent in suit can be anticipated or limited only by things which existed prior to the date of the *actual invention*. The date of application for the patent is immaterial.

Klein vs. Russell (19 Wall., 433).

The 21st assignment of error is not good, because the instruction therein requested was merely an abstract question of law not involved in the case. As a question of law it may be correct, but no such question was involved in the case. The defendant in error had not advanced

any proposition opposed thereto, and hence there was no necessity for any such instruction. To have given it would merely have tended to confuse the jury. Said the Court in *Haines vs. McLaughlin* (135 U. S., 598):

“It is not error to refuse to instruct as to an abstract question, and instructions should never be given upon hypothetical statements of fact of which there is no evidence.”

And such is the universal rule on the subject.
See

Dwyer vs. Dunbar (5 Wall., 329).

Hamilton vs. Russell (1 Cr., 318).

Bryan vs. United States (1 Black., 149).

McNeil vs. Holbrook (12 Pet., 84).

Rhett vs. Poe (2 How., 483).

Beaver vs. Taylor (1 Wall., 637).

Chicago vs. Robbins (2 Black., 429).

N. Y., etc., Co. vs. Fraser (130 U. S. 611).

The 22d assignment of error is bad, because—
(1.) It undertakes practically to tell the jury that the Button patent is a full anticipation of the second claim of Cassidy’s patent, (2) Cassidy’s invention was made prior to the issuance of Button’s patent, and in no event, therefore, could Button be an anticipation, and (3) Whatever there was in the instruction proper to give had

already been given by the Court in its general charge to the jury.

The instruction asked undertakes to give a description of the Button mechanism as set forth in his patent, and then tells the jury that, if they find such description in the Button patent, they should conclude that the Button patent is a *full anticipation*, etc. This is nothing more than a cunning and artful way of telling the jury that the Button patent was a *full anticipation*. It is a piece of legal legerdemain not to be tolerated. It was a question of fact solely for the jury to decide what the Button patent did describe, and whether or not such description amounted to an anticipation. It is true the instruction does not *in terms* undertake to say what is the description of the Button patent, but it does say, if a given construction (which will be found to be the exact description of the Button patent) is shown in said Button patent, then there is a full anticipation. This amounts to telling the jury that the Button patent is a full anticipation, and if the instruction had been given, the jury would have been compelled to find an anticipation, and thereby the decision on a pure question of fact would have been taken from them. The instruction was an attempt to do indirectly what it was not proper to do directly.

(2.) But further, Cassidy's invention was actually made prior to the date of Button's patent, and in no event, therefore, could the Button patent be an anticipation, even if it showed the identical thing claimed by Cassidy. The Button patent is dated September 22, 1874, (Record 43). The date of Cassidy's invention is April, 1874, (Record pp. 82-3). We introduced a drawing to prove that fact made in April, 1874, and Cassidy testifies that he made the invention at that time and actually built a drier embodying it.

When a patent in suit is sought to be anticipated by a patent prior in date, the plaintiff is allowed by way of rebuttal to prove that his invention was actually made before the date of the anticipating patent, and by such rebuttal evidence he destroys the force of the alleged anticipating patent.

St. Paul Plow Works vs. Starling (140 U. S., 198).

Clark Thread Co. vs. Willimantic Linen Co. (140 U. S., 492).

Loom Co. vs. Higgins (105 U. S., 592).

Elizabeth vs. Pavement Co. (97 U. S., 126).

Tyler vs. Crane (7 Fed. Rep., 775).

(3.) But finally, whatever there was in the instruction proper to give had already been given by the Court in its general charge. See charge of the Court at page 115 of Record from line 15

to line 39. All that was proper to say about the Button patent was there said, and it was sufficient to enable the jury to pass on the question of the anticipating force of the Button patent.

The 23d and 24th assignments of error are bad because—

1. They embrace abstract questions of law which were not in the case, and,

2. The counsel for plaintiff in error waived them.

These two instructions are aimed at the question of *aggregation*, the contention being that there was no joint action between the lower set of catches in Cassidy's patent and the set immediatly above, and that, therefore, the second claim was void as being a mere aggregation if it included both sets of catches.

In answer to this it may be said that no such question was involved in the case. We did not contend for such construction of the claim, because it was not necessary for our case. Nor did the Court give any such construction of the claim. Consequently, the instructions embodied merely abstract questions of law not pertinent to the case, not applicable to or explanatory of any facts in the case, and were very properly refused.

It is not error to refuse to give an instruction on

an abstract question of law not involved in the case.

But whatever merit there was in the instructions asked, was waived at the trial. At pages 115-16 of Record we find the following in the Judge's charge:

“A combination of mechanical elements, in order to be patentable, must produce a different force, or effect, or result in combined forces or processes that are different from those given by their separate parts. [N. B. This is a clear definition of aggregation in the words of the Supreme Court.—J. H. M.] There has been some discussion here as to whether or not this was a patentable combination or an aggregation. No instructions have been asked by counsel on either side, and I suppose none are requested upon that point. Unless counsel desire it, I shall not submit that question to the jury. If they do desire it, I shall give the jury instructions as to the distinction between a patentable combination and an aggregation.

Mr. Wheaton—I did not have time. All I meant by that, was, if these upper set of catches were to be read into the claim, that that would be an aggregation, as the expert testified that they acted independently of each other. As to the other part of it, I do not think it will apply.

The Court—I shall not give any instruction about that.”

We submit that this amounts to a waiver of the two instructions under consideration. They relate solely to aggregation. The Court asked counsel

if he insisted on having an instruction on the point. It appears that he did not so insist, and thereupon the Court stated that no instruction on the subject would be given. Counsel cannot now insist that there was error.

The 25th assignment of error is bad. It is ambiguous and confusing. It is not apparent whether it refers to the *invention* made by Cassidy or to an *actual drier* made by him. Besides, it refers to the *application* for the Button patent, whereas it should have referred to the *issuance*, because we have already shown that a prior patent can avail as an anticipation only from the date of its *issuance* and not from the date of *application*, and we have also shown that there is no competent evidence in the case showing the date of Button's application.

And finally, even if it be true that Cassidy's spring catches were not made until after Button's application, that would not affect the case, because the Button patent is not an anticipation of Cassidy's second claim. The Court submitted that question of fact to the jury and they found against such alleged anticipation. Counsel cannot now urge that here was an anticipation. That question of fact is settled and is not reviewable.

VI.

ALLEGED ERRORS OF THE COURT IN INSTRUCTING JURY AS IT DID CONCERNING MECHANICAL EQUIVALENTS. ASSIGNMENTS OF ERROR 35, 36, 37, 38, 39 and 40.

The instruction objected to by the 35th assignment of error reads as follows:

“ If you find that the defendants have used all of these elements or their mechanical equivalents, combined together and accomplishing substantially the same result in the same way, then they have infringed this claim, that is, of course, if you find that there has been an invention. If there has been no invention you do not reach that question.

“ When, in mechanics, one device does a particular thing or accomplishes a particular result, every other device known or used in mechanics which skillful and experienced workmen know will produce the same result, or do the same particular thing, is a known mechanical substitute for the first device. It is sufficient to constitute known mechanical substitutes, that when a skillful mechanic sees one device doing one particular thing that he knows the other devices, with whose use he is acquainted, will do the same thing.”

In regard to the first portion of this instruction we shall consider the matter later on.

The latter portion is clearly correct. It is the identical language used by Judge Sawyer, in defining mechanical equivalents, in the case of *Carter vs. Baker* (1 Sawy., 512), the language being copied

bodily from that decision. That definition of Judge Sawyer has never been questioned, but has been repeatedly affirmed and re-affirmed by nearly all the Circuit Courts of the land. In fact the case of *Carter vs. Baker* is considered to be one of the celebrated cases in the annals of patent law, solely on account of this definition of mechanical equivalents.

The 36th assignment of error is clearly bad. The instruction there attacked correctly states the law governing the subject under discussion. It reads as follows:

“If you find that the gravity catches of defendant do the same thing in substantially the same way as the spring catches of plaintiff, and that a skilled mechanic, upon seeing the spring catches work, would know that gravity catches would do the same thing in the same way, then the two are mechanical equivalents.”

It would take more ingenuity than we possess to pick a flaw in this instruction. The only difference between the patented and infringing machines was in the catches. One had spring catches, the other gravity catches. If these two kinds of catches were mechanical equivalents there was an infringement. Otherwise not. Hence it was proper for the Court to give the jury the rule of law by which that question was to be determined. The rule announced was correct, and, therefore, the instruction was proper.

As to the 37th assignment of error. The instruction there given reads as follows:

“When a patent is not for a mere form, the patentee is not required to claim his invention in all the forms in which it may be embodied. All that he is required to do is to describe and claim it in the best form he has contemplated using it, and having done that, he will be protected in all forms by virtue of the doctrine of mechanical equivalents.”

This is in accordance with the law. Section 4888 of the Revised Statutes provides that the applicant for a patent, in case of a machine, “shall explain the principle thereof and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions.”

After he has done that, he will be protected, however the form of his invention may be varied by others. He is not required to describe or claim *all the forms* in which his invention may be embodied, but only *one form*, viz: “The best form in which he has contemplated using it.”

The principle is as old as the hills that in patent law formal changes are nothing, mere mechanical changes are nothing.

In *Murphy vs. Eastman* (5 Fish., 306), the patentee had claimed a certain device in an *angular* form. The infringer had used it in a *circular* form. Said Judge Shepley:

“The patentee does not claim in terms the thing patented, however its form and proportions may be varied. But the law so interprets his claim without the addition of those words. In contemplation of law, after he has fully described his invention and shown its principle and claimed it *in a form which perfectly embodies it*, unless he disclaims other forms, *he is deemed to claim every form in which his invention may be copied.*”

In *LeRoy vs. Tatham* (2 Blatch., 486), Judge Blatchford said:

“A change of form is not a substantial change. A patentee is not confined to the precise arrangement shown in his patent. Formal changes are nothing; mere mechanical changes are nothing. All these may be made outside the description of the patent.”

In *Reed vs. Smith* (40 Fed. Rep., 886) and in *Ives vs. Hamilton* (92 U. S., 426) it was held that a true curve was the equivalent of a series of straight lines meeting one another at an angle.

In *Winans vs. Denmead* (15 How., 122) it was held that a car-body made in the form of a frustum of a cone was the equivalent of one made in an octagonal shape.

In *Manufacturing Co. vs. Bushing Co.* (31 Fed. Rep., 76) and also in *The Accumulator Case* (38 Fed. Rep., 143), it was held that a square hole was the equivalent of a round one.

In *Brush vs. Condit* (132 U. S., 39) it was held

than an annular or round clamp was the equivalent of a square or rectangular clamp.

And in the English case of *In re Newell* (4 C. B., 269) a cylinder with a spherical shaped top was held the equivalent of a cone.

The 38th assignment of error is bad for the same reasons given concerning the 37th. The instruction therein referred to is of the same general character as that referred to in the 37th. The same argument applies to both.

The 39th assignment of error is also bad. Counsel for plaintiff in error has indulged in an extensive argument on the subject-matter of this instruction, which reads as follows:

“The fact that in his original application plaintiff claimed as an element of his second claim *spring or other catches*, and that he afterwards struck out the words *or other*, leaving the element simply *spring catches*, does not limit his claim to spring catches nor deprive him of gravity catches, if the latter are mechanical equivalents of spring catches.”

In his original application to the Patent Office Cassidy asked for two claims, reading as follows:

“First. The flues C, passing around the drying chamber as shown, being enclosed at E, H, J, and having openings I, *m*, leading into the drying chamber from the cases, substantially as and for the purpose herein described.

Second. The device consisting of the stationary

posts K and the vertically moving posts L, provided with the spring or other catches *n n*, together with means for moving the posts L L for the purpose of elevating the trays substantially as herein described." (Record 34.)

In answer to this application the Patent Office replied:

"The claims are *not in the preferred form*. Fruit-driers being old, applicant's invention, if he has made any, must consist of some novel feature or combination of features, *in a fruit-drier*, and this, it is suggested, is what should be claimed.

For the first claim reference is made to *Dryers*, A. Mackey, 137,459, Apr. 1, 1873; Harrison & Savery, 156,849, Nov. 17, 1874; *Fruit-Dryers*, Mayhew, 94,967, Sept. 21, 1869; *Grain Dryers*, Eaton, 115,833, June 13, 1871.

"For 2d claim, see *Fruit Dryers*, M. P. Smith, 107,417, Sept. 13, 1870, re-issued; J. O. Button, 155,286, Sept. 22, 1874, and A. C. Lewis, 29,390, July 31, 1860. The application is rejected." (Record 34.)

In answer to this letter Cassidy filed an amendment in which he erased the old claims, and in lieu thereof inserted the following claims:

"1. In combination with the drying chamber the pipes or flues C, passing diagonally along the slotted openings I, around and outside of the dryer, and provided with coverings E, H, J, substantially as and for the purpose set forth."

"2. In combination with a drier the stationary posts K, provided with spring catches *n n*, and the

vertically moving posts L, provided with spring catches $n^1 n^1$, and suitable mechanism for operating the posts L, substantially as and for the purpose set forth.” (Record 34-5).

These two claims were thereupon allowed by the Patent Office and are the present claims of the patent.

The argument advanced by counsel for plaintiff in error (see brief, pp. 15-18) is that the Patent Office specifically refused to allow the claim for “spring or other catches,” and that Cassidy thereupon amended by striking out the words “or other,” and asking for “spring” catches alone. This, they argue, was an abandonment of the “other” catches and a limitation of the claim to “spring” catches, without allowing the patentee the benefit of equivalents.

In reply to this we say the *Patent Office did not* refuse to allow the patentee the “other” catches. They simply said that the claims were not “in the preferred form.” We note two reasons why they were not in the preferred form. First, the claims were not limited to a *drier*, but were broad enough to cover the mechanical devices in all connections. This was a correct ruling. The specification stated that the invention was a drier, or rather an improvement in driers. Consequently the claims should have been so limited, and the

patentee amended by making a “drier” an element in each claim.

Secondly: The words “spring or other catches” were not in the preferred form, and the words “or other” were surplusage. It is a well settled rule of the Patent Office that a claim must not be in the alternative, and such a claim is generally refused.

Ex parte Holt (29 O. G., 171).

Ex parte McDougall (18 O. G., 130).

Ex parte Reid (15 O. G., 882).

Carr vs. Rice (1 Fish, 325).

Original Claim 2 being in the alternative in calling for spring *or other* catches, it was proper for the applicant to strike out the words “or other.” While this action left the claim with the word *spring* alone, it did not deprive the applicant of the benefit of equivalents of spring catches. This results from the provision of the statute already cited, which requires an applicant for a patent to describe and claim his invention only in *one form*, viz: the *best form* in which he has contemplated employing it, and then he will be protected in *all forms* which are its equivalents. To repeat the language of Judge Shepley, heretofore quoted from the case of *Murphy vs. Eastman* (5 Fish., 306):

“The patentee does not claim in terms the thing patented, *however its form and proportions may be varied*. But the law so interprets his claim without the addition of those words. In contemplation of law, after he has fully described his invention and shown its principle and claimed it *in a form which perfectly embodies it* unless he disclaims other forms (Note. That was not done in this case—J. H. M.) *he is deemed to claim every form in which his invention may be copied.*”

In the case cited the invention was claimed in an *angular* form, while the infringer had used it in a *circular* form. If the claim had originally been worded as calling for “an *angular or circular* form,” it would have been objectionable, just as Cassidy’s original second claim was. It was not necessary to add the words “or circular,” because the claim already in contemplation of law, covered that form. The words “or circular” were surplusage, they were unnecessary, they were contrary to the rule of the Patent Office prohibiting claims in the alternative. So too of Cassidy’s case. The words “or other” were surplusage, because the word “spring” already covered them.

But whatever effect may be attributed to Cassidy’s course in eliminating the words “or other,” it can go no further than to deprive him of *such other catches as are not equivalents of the springs*. We do not contend that the claim covers *all other*

catches, but only *such others as are the equivalents of the springs*, and the instruction given carefully notes this distinction. It may be that the claim as originally framed was too broad for that reason, in that it attempted to cover *all other* catches, whereas Cassidy's invention included only spring catches or their equivalents.

For instance, the catches shown in the prior patent of Smith consist of the threads of revolving screws (Record 50 *et seq.*) Undoubtedly they are *other catches*, but they are not the equivalents of spring catches, because they operate on a different principle.

The same is true of Alden's drier. His catches are lugs on an endless chain. They too are *other catches*, but are not the equivalents of spring catches, because they likewise work on a different principle and in a different way.

If the claim as originally drawn had been allowed to stand, its language might have been broad enough to include the screw-threads of Smith and lugs of Alden, things not invented by Cassidy and not within the scope of his patent. Therefore, it was eminently proper for him to strike out the broad words "or other" in order to avoid such result. But in so doing he did not intend to deprive himself of *such other catches as were the equivalents of his springs*, nor did the

Patent Office so rule, nor is such the scope of his claim.

This position is rendered unassailable when we remind the Court, *First*: That in the first drier built by Cassidy in April, 1874, and in the first drawing of his invention made about the same time, he used gravity catches, not springs (Record 82-3-4); and *Second*: In the specification of the patent near the close we find the following statement: "Catches which would fall out by gravitation might be substituted for the springs in some cases."

This clause was in the original specification when filed, and was never stricken out. It shows conclusively that the patentee considered spring and gravity catches to be equivalents, that he contemplated using both, that both were in the purview of his invention.

We say, therefore, that gravity catches were just as much a part of Cassidy's invention as spring catches. Gravity catches being the equivalents of spring catches, they being the same thing in a different form, and the claim calling for the best of those two forms (as required by the statute), it is clear that the claim covers both forms.

The cases cited by counsel, on page 16 of their brief, do not militate against these views. They merely decide that where a combination claim, as

originally applied for, is anticipated, and the Patent Office compels the applicant to introduce into the combination another element as a prerequisite to the issuance of a patent, and in order to avoid the anticipation, the patentee cannot afterwards drop that added element and contend that his patent covers a combination which has neither that element nor its equivalent. Such was the case of *Shepard vs. Carrigan* (116 U. S., 593), cited, and the other cases quoted are to the same effect.

It will be seen by the most casual observer that such is a very different proposition from the one under discussion. All we contend for is that our second claim covers spring catches and *such other catches as are their mechanical equivalents*.

We do not contend that it covers *such other catches as are not mechanical equivalents*, that is to say, *all other catches*, which was the thing called for by the original claim and subsequently eliminated. Therefore, it is plain that we are not trying to make our patent include something which was struck out by the Patent Office as not being within the claim.

The precise contention of opposing counsel is that we are not entitled to invoke the doctrine of equivalents at all. They admit in their brief that the gravity catches used by them are the mechanical equivalents of our spring catches. (Brief 17.)

And one of the defendants, while on the stand, went so far as to say: “In my judgment, a spring catch is the mechanical equivalent of a gravity catch. The gravity catches used in my machine are the mechanical equivalents for the spring catches used in the Cassidy machine.” (Record 60.) And yet, in the teeth of such admissions, it is claimed that Cassidy is not entitled to invoke the doctrine at all, because (they assert) all he did himself was to substitute mechanical equivalents for old devices, and that “the same combination with other equivalent elements already existed and he did not invent it.” (Brief 17.)

In this position there are two palpable errors—one an error of fact, the other an error of law. The error of fact is the statement that Cassidy’s combination, with other equivalent elements, already existed. We deny it point blank. It is merely a bold, bald statement, unsupported by any evidence in the Record, and exists only in counsel’s vivid imagination.

Cassidy’s combination, as set forth in his second claim, consists of six elements, viz:

1. A drier.
2. Four stationary posts.
3. A series of spring catches on said posts.
4. Four movable posts arranged to have a vertical reciprocating motion.

5. A series of spring catches thereon.

6. A mechanism for operating the movable posts.

We challenge counsel to point out this combination with other equivalent elements in any device prior to Cassidy's invention. Certainly the Smith does not show it. Its revolving metal screws cannot be called moving posts provided with spring catches, and there is no pretense of four stationary posts provided with spring catches. Nor does that patent show any equivalent combination.

The Alden drier we have already considered and shown to be no equivalent. It has not stationary posts provided with catches, no movable posts provided with catches and having a vertical reciprocating movement.

The Button patent was subsequent to Cassidy's invention and cannot be called a prior device; and besides, it does not show any equivalent combination.

There are no other patents in the Record worthy of note, and we assert that counsel's broad statement quoted *supra* is unsupported by a scintilla of evidence.

The error of law referred to consists in losing sight of the fact that every patentee is entitled to the doctrine of mechanical equivalents in some

form or other. Sometimes he is entitled to the doctrine broadly, as in the case of pioneer or primary inventions; again, he is entitled to it in a more limited and restricted way, as in the case of mere improvements on old devices. But he is always entitled to the doctrine in a greater or less degree. It is merely a question of degree. Counsel's theory would seem to be that only primary inventors are entitled to the doctrine. In this he errs. The doctrine applies to all inventions, whether they be primary or secondary.

This question has been frequently considered by the Courts. Thus, in *Seymour vs. Osborne* (11 Wall., 516), Mr. Justice Clifford said in reference to a patent for an improved combination of old devices:

“ Mere formal alterations in a combination in letters patent, however, are no defense to the charge of infringement, and the withdrawal of one ingredient from the same and the substitution of another, which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination, if the ingredient substituted performs substantially the same functions as the one withdrawn. *Patentees, therefore, are entitled in all cases to invoke to some extent the doctrine of equivalents. * * ** *Bona fide inventors of a combination are as much entitled to suppress every other combination of the same ingredients to produce the same result, not substan-*

tially different from what they have invented and caused to be patented, as any other class of inventors. All alike have the right to suppress every colorable invasion of that which is secured to them by their letters patent, and it is a mistake to suppose that this Court ever intended to lay down any different rule of decision."

Affirming this doctrine in *Gould vs. Rees* (15 Wall., 187), the same learned Justice said:

" Mere formal alterations of a combination in letters patent do not constitute any defense to the charge of infringement, as the inventor of a combination is as much entitled to suppress every other combination of the same ingredients to produce the same result, not substantially different from what he had invented and caused to be patented, as the inventor of any other patented improvement. Such inventors may claim equivalents as well as any other class of inventors, and they have the same right to suppress every other subsequent improvement, not substantially different from what they have invented and secured by letters patent.
* * * *Bona fide* inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements; by which is meant that a patentee in such a case may substitute another ingredient for any one of the ingredients of his invention, if the ingredient substituted performs the same function as the one omitted and was well known at the date of his patent as a proper substitute for the one omitted in the patented combination."

And still again in *Gill vs. Wells* (22 Wall., 1), the same Justice says:

“Alterations, however, in combinations which are merely formal, do not constitute a defense to the charge of infringement, as the inventor of a new and useful combination is as much entitled to claim equivalents as any other class of inventors.”

The late Judge Sawyer has occasion to consider this question in *Tatum vs. Gregory* (41 Fed. Rep., 142), which was a suit on a patent for an improvement on old devices, and where the identical question under consideration was raised. He disposed of it by saying:

“The case of *McCormick vs. Talcott* (20 How., 405), was relied on very strongly as limiting this construction. The point covered there relates to the use of mechanical equivalents or substitutes. That case once troubled me a good deal. It was cited in the first patent case that I ever tried, when I was not very familiar with the subject. It was pressed on me very earnestly as holding that the doctrine of mechanical equivalents or substitutes had no application to improvements in patents, or patents for combinations of old elements, and only related to original inventions and new devices. The point was argued and pressed very earnestly. The loose language used in the opinion, perhaps well enough as related to the facts of that case, afforded some ground for such a contention. I myself could not see why the doctrine should not be applicable to combinations and improvements as well as to original patents and new devices. I

rejected that theory. I was afterwards fully sustained in the view that I took in the cases of *Gould vs. Rees*, 15 Wall., 192; *Seymour vs. Osborne*, 11 Wall., 555, and *Gill vs. Wells*, 22 Wall., 28, where the Court stated in very decided terms that the doctrine of equivalents was as applicable to improvements and combinations of old elements, as to original inventions and new devices. The contention of defendants in this case, however stated, really involves that doctrine, whether equivalents in the character of substitutes are available in patents for combinations and improvements. They clearly are, and it is so very distinctly stated in those cases."

Such is the doctrine laid down by the text-writers also.

Says Walker (§ 350):

"The doctrine of equivalents may be invoked by *any* patentee whether he claimed equivalents in his claim, or described any in his specification, or omitted to do either or both of these things."

And so likewise Robinson (Vol. 3, § 258):

"The doctrine of equivalents applies alike to all classes of invention and to all inventions of whatever class."

The true doctrine is one merely of degree. In the case of primary inventions the doctrine is broadly and liberally applied, while in the case of secondary inventions, or mere improvements on old devices, the rule is not so broad or liberal, but only those things are held to be equivalents which

are mere *colorable* evasions of the patented device.

In this connection counsel for plaintiff in error professes to find great similarity between the patent in suit and that involved in *Railroad Co. vs. Mellon* (104 U. S., 112), but the most casual observer will note that the alleged resemblance is purely imaginary.

In that case the invention consisted in a mode of attaching tires to the wheels of locomotives, the essential feature of which was a flange having a *curved or rounded* corner. As originally drawn the specification included a flange with an *angular or square* corner. This claim was twice rejected on the prior patent of Hodge, which showed the *angular* flange. Thereupon the patentee amended his specification by saying:

“ I am aware of the invention described in patent of N. Hodge, November 18, 1851, but I wish it to be understood that I do not claim the invention therein described, viz.: the *angular* flange upon the inner edge of the wheel and the flange upon the outer edge of the wheel, but I do claim as my invention the wheel with the *curved flange* upon the inner edge in combination with a *rounded* corner to fit said *curved* flange, etc.”

This was an express disclaimer of the *angular* flange and a direct limitation of the invention to a *curved one*. Hence the Court held that the invention was limited to the *curved flange*, and did

not cover the *angular* one. The patentee made form the essence of his invention and disclaimed other forms. But in our case the patent is not for a *mere form*. The patentee claims his invention in one form, it is true, but he does not disclaim other forms. Hence he is protected in all forms, because form is not of the essence of his invention. Therefore the instructions referred to in the 37th, 38th and 39th assignments of error were correct, under the decisions of the Court in *Murphy vs. Eastman* (5 Fish., 306), *LeRoy vs. Tatham* (2 Blatch, 486), *Reed vs. Smith* (40 Fed. Rep., 886), *Ives vs. Hamilton* (92 U. S., 426), *Winans vs. Denmead* (15 How., 122), *Brush vs. Condit* (132 U. S., 39), heretofore cited.

The 40th assignment of error is also bad.

The instruction against which this assignment is aimed is good law. It reads as follows:

“If you find that the defendants have used all the specified elements of plaintiff’s second claim, except that they have substituted gravity catches instead of spring catches, and you further find that gravity catches do the same thing in substantially the same way as the spring catches, then the defendants have infringed that claim.”

Of course if we have shown that we are entitled to invoke the doctrine of equivalents, this instruction is correct. It is substantially the language used by the Supreme Court in the *Paper*

Bag Cases (97 U. S., 120), and there can be no question of its correctness as a proposition of law.

That the gravity catches are the equivalents of the springs is conceded by counsel and admitted by their clients. We are, therefore, at a loss to conceive any error in the instruction.

VII.

ALLEGED ERRORS OF THE COURT IN CHARGING THE JURY AS IT DID ON THE QUESTION OF DAMAGES. ASSIGNMENTS OF ERROR 26, 27, 28, 29, 30, 31, 32, 33, 34 and 41.

Before considering these matters specially we here repeat that portion of the Judge's charge which was given on the subject of damages. It reads as follows:

“ Upon the subject of damages I shall give you very few instructions. I shall instruct you that a license fee cannot be allowed as damages in a patent case unless it is proved that a license fee was fixed by the plaintiff, and that he was able to sell rights to others at that price in sufficient quantities to show that the public acquiesced in that price and voluntarily paid it for the right to use the invention. There is no fixed royalty or license fee that can be applied as a rule of damages in this case unless the plaintiff has proven that he was able to sell rights to use the inventions at the price fixed by him. If he did not make sales in such numbers and at such uniform prices as to create an established license fee, then he is not

entitled to claim any such license fee as a rule of damages in this case. If, however, you find from the evidence that plaintiff has established a fixed uniform royalty for the use of his invention by others, and has collected the same from other persons in several instances, then I instruct you that the said royalty is the proper measure of damages.

In all cases the burden of proof is upon the plaintiff to show the amount of his damages. The damages must be proved by competent reliable evidence. They must not be guessed at or conjectured."

This last paragraph was given at the instance of plaintiff in error. It will be found at page 121 of Record. The remainder of the charge quoted will be found at pages 117 and 118.

We claim that these portions of the charge taken together are full, complete and correct expositions of the law on the subject, so much so that at the close of their brief counsel for plaintiff in error are compelled to say: "To the general fairness of the charge we pay our tribute of respect." If so, there was no error in refusing to give the instructions now complained of. But nevertheless, we shall consider them *seriatim*.

The 26th assignment of error. The instruction there asked was very properly refused. We never contended that the plaintiff was entitled to "recover as damages *the profits that he made by mak-*

ing and selling the driers as an entire machine," and the jury did not award any such damages. That question was not in the case at all, and however correct it may be as an abstract question of law, it was entirely irrelevant to any issue involved. The entire profits usually made by Cassidy on his machines were \$125 each. The number of infringing driers made and used by defendants was 18. Hence, Cassidy's entire profits on 18 driers would have been \$2,250. We never claimed that amount of damages at any time during the trial. We claimed a royalty or license fee of \$100 for each drier. The jury awarded us only \$1,350 or \$75 per drier, which was neither the full royalty nor the full profits. Hence, the instruction was not pertinent to any issue in the case. It was simply an abstract proposition of law, and as such was properly refused.

The 27th assignment of error. This was properly refused for two reasons. In the first place it undertook to instruct the jury on a question of fact by telling them point blank that the plaintiff was not entitled to recover any license fee as damages. *But that was purely a question of fact for the jury to pass on* and it would have been error for the Judge to take it away from them and pass on it himself.

In the next place, it undertakes to make a dis-

inction between the amount of a license fee under a patent in the State of California and elsewhere. Such is not the law. In the absence of evidence to the contrary, a license fee is a license fee throughout the entire United States. Uniformity is its prime requisite. Says Mr. Walker (Walk. Pats., § 557):

“A defendant may successfully object to a given royalty * * * * unless it was uniform,” and such is the general law on the subject.

It may be true that a patentee may under special circumstances fix different royalties for different States, but in such case there must be some evidence of such course. In this case there is no evidence that a different royalty was fixed for different States; and in the absence of such evidence it must be presumed that the royalty was uniform throughout the United States; but there is no evidence of such course in this case, and in the absence thereof it must be presumed that the royalty was uniform throughout all localities. Had it been otherwise, it was the duty of defendant to show it.

The 28th assignment of error. Even if the instruction here asked correctly states the law on the subject and the refusal to give it was error, still it was in no way prejudicial to plaintiff in error, because the jury did not award us the full

license fee. The full license fee was \$100 per drier. The jury awarded damages at the rate of \$75 per drier. Evidently they considered that \$75 was a fair proportion of the license fee for the one claim infringed. Hence we do not see how the plaintiff in error was prejudiced by the refusal to give the instruction. If error it be, it was a harmless one, one not affecting the verdict in any way whatever; and if it had been given, it would not have altered the verdict.

“ To render an exception available in this Court, it must affirmatively appear that the ruling excepted to affected, or might have affected the decision of the case.”

Florida R. R. Co. vs. Smith (21 Wall., 255).

In the language of Mr. Justice Blatchford:

“ No judgment should be reversed in a Court of error when it is clear that the error could not have prejudiced, and did not prejudice, the rights of the party against whom the ruling was made.”

Lancaster vs. Collins (115 U. S., 227), and cases cited.

West vs. Camden (135 U. S., 521).

The 29th assignment of error. The same answer applies to this as was given to the 28th.

In addition thereto the instruction is liable to further objections. It tells the jury that the mere

sale of licenses, while the patent had a certain number of years to run, “ does not *of itself* prove ” that the patentee could have made subsequent sales at the same amount when the patent had a less number of years to run. But there was more evidence on the subject than the *mere fact* stated above. Consequently, it would have been error to give the instruction, because it was an abstract question of law not called for by the facts of the case. Such instructions are never proper and it is no error to refuse them.

The 30th assignment of error. There was no error in refusing to give this instruction because it had already been substantially given.

The instruction which was refused amounted simply to saying that the plaintiff must prove his damages by reliable testimony, or else can recover only nominal damages. This proposition of law had already been given to the jury in slightly different language.

The Court had already said:

“ In all cases the burden of proof is upon the plaintiff to show the amount of his damages. The damages must be proved by competent reliable evidence. They must not be guessed at or conjectured.” (See Record 121, near bottom.)

And in connection with this the Court had also said to the jury:

“ If you do not find any royalty the plaintiff would be entitled only to nominal damages. (See Record 121, bottom.)

The 31st and 32d assignments of error. These instructions are each a mere statement of an abstract proposition of law not relevant to the issues of the case, and as such were properly refused.

They were copied bodily from the decision of Mr. Justice Field in *Garretson vs. Clark*, where he was discussing certain abstract propositions of law. We do not deny their correctness, but they are not applicable to the issues here involved. There was no occasion for them. The “defendant’s profits” were not issue. The instructions, we repeat, were simply abstract propositions of law not pertinent to the case.

The 33d and 34th assignments of error. These instructions were palpably bad, because they undertook to take away from the jury questions of fact which were proper to be passed on by the jury, and the jury alone. It was virtually taking the entire case from them. Hence, the instructions were properly refused.

The 41st assignment of error. This is aimed at an instruction which was given by the Court at the instance of defendant in error. It reads as follows:

“ If, however, you find from the evidence that

plaintiff has established a fixed uniform royalty for the use of his invention by others, and has collected the same from other persons in several instances, then I instruct you that the said royalty is the proper measure of damages.”

The objection raised to this instruction is aimed at the words “in several instances”; but this complies with the law. It is settled that a *single instance* of a royalty collected is not sufficient evidence of an established royalty, but that a plurality of instances is.

“Proof of a *single license* was given in this case, but it cannot, in view of the circumstances, be regarded as affording the only measure of compensation to which the plaintiff is entitled” (*Judson vs. Bradford*, 3 Ban. and Ard., 549—Clifford).

“The market value of the patent in question could not be established by the *single license* referred to” (*Vulcanite Co. vs. American Co.*, 36 Fed. Rep., 379—Butler).

“Proof of a *single license* is not enough” (*Graham vs. Plano Mfg. Co.*, 35 Fed. Rep., 598—Blodgett).

“The sale of a single license is not sufficient to establish a royalty” (Walker).

“A single license cannot show a custom” (Robinson).

But on the other hand a plurality of instances (several), will be sufficient for the purpose.

“ It is a general rule in patent causes that established license fees are the best measure of damages that can be used * * * As to the sufficiency of the proof, we see no occasion to disturb the conclusion reached by the master on this point. The complainant proved *several instances* of licenses given by him to large sewing machine companies, the fees on which were regularly paid, and corresponded with the rate allowed by the master. We think that the defendant has no occasion to complain of the amount awarded ” (*Clark vs. Wooster*, 119 U. S., 322—Bradley).

In view of these authorities the instruction was correct.

But even if there should be a technical or verbal error in the instruction when standing alone, yet taken in connection with the rest of the general charge on the subject of damages, it is not erroneous and could not have prejudiced defendant's case. The Court said:

“ * * * A license fee cannot be allowed as damages in a patent case unless it is proved that a license fee was fixed by the plaintiff, and that he was able to sell rights to others at that price in sufficient quantities to show that the public acquiesced in that price and voluntarily paid it for the right to use the invention. There is no fixed royalty or license fee that can be applied, as a rule of damages in this case, unless the plaintiff has proven that he was able to sell rights to use the invention at the price fixed by him. If he did not make sales in such numbers and at such uniform

prices as to create an established license fee, then he is not entitled to claim any such license fee as a rule of damages." (Record 117.)

Then followed the instruction now under consideration. Taking the whole charge on this subject together, we insist that there was no error.

The rule on this subject was stated by Mr. Justice Story, at a very early day, to be as follows:

"The whole scope and hearing of a charge must be taken together. It is wholly inadmissible to take up detached passages and to decide upon them without attending to the context, or without incorporating such qualifications and explanations as naturally flow from the language of other parts of the charge. The whole is to be construed as it must have been understood both by the Court and jury at the time it was delivered."

Magniac vs. Thomson, 7 Pet., 346.

And to the same effect are

Carver vs. Astor (4 Pet., 80).

Spring vs. Eagar (99 U. S., 659).

Castle vs. Bullard (23 How., 172).

In conclusion we submit that the trial had in this case was in every respect fair and impartial and no error of law is made to appear in the Record. The charge of the Court is without a flaw. Indeed, it was so plainly and strikingly fair to both parties, that even the technical counsel for plaintiff in error are compelled to say in their

brief: "To the general fairness of the charge we pay our tribute of respect."

The damages awarded are certainly not excessive. They are less than what we claimed and are less than the usual rate of royalty charged and collected by the patentee from others. No motion for a new trial was made, so that the Court could have had an opportunity to reduce them, if they were too large, and we submit that this Court should not disturb the verdict.

Respectfully submitted.

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